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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/697,009

10/25/2000

Bruce L. Davis

60319

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23735 7590 05/06/2009

DIGIMARC CORPORATION  
9405 SW GEMINI DRIVE  
BEAVERTON, OR 97008

EXAMINER

JANVIER, JEAN D

ART UNIT

PAPER NUMBER

3688

MAIL DATE

DELIVERY MODE

05/06/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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*Ex parte:* BRUCE L. DAVIS and GEOFFREY B. RHOADS

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Application No. 09/697,009  
Technology Center 3600

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Mailed: May 6, 2009

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Before VASCO S. HARPER, *Paralegal Specialist*.

HARPER, *Paralegal Specialist*

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences (BPAI) on March 25, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below:

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The Examiner's Answer mailed August 29, 2007 is unacceptable for the following reasons.

The Examiner has chosen to combine a response to both the Brief and the Reply Brief in the Examiner's Answer mailed August 29, 2007, i.e., on page 9 of the Answer the Examiner has placed a heading and sub-heading that reads:

I. In Response To The Appeal Brief Filed on 03/16/06

(10) Response to Argument

And on page 15 of the Answer, the Examiner has placed a heading and sub-heading that reads:

II. In Response to the Reply Brief filed on 7/17/06

NEW GROUND(S) OF REJECTION

Such a combined Answer is not acceptable to the BPAI. The Examiner should issue a separate action for each response as there are different rules governing the response(s) to the different documents and the BPAI will consider each on its separate merits.

Additionally, as Appellants have correctly pointed out in their "Motion to Strike" and the subsequent "Letters Re Supplemental *Answers* and Renewed *Motion to Strike*" filed May 25, 2007 and October 19, 2007 respectively (motions which the Examiner seems to have virtually ignored), "[a] supplemental examiner's answer responding to a reply brief may not include a new ground of rejection." New issues raised in the Reply Brief should be addressed without entering a new ground of rejection. Manual of Patent Examining Procedure (MPEP) 1207.05(I), 37 CFR 41.43 (a)(2).

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Appellants' objections as per the motion should be considered.

As an incidental, the paper entered as a Miscellaneous Letter filed by Appellants on February 5, 2008 of a BPAI prior decision rendered January 31, 2008 states that the decision is a "precedential decision". The decision has not been officially designated as a Precedential Decision per se by the BPAI.

Accordingly, it is

ORDERED that the application is returned to examiner for the examiner to:

- (1) take corrective action for resolving the unacceptable Answer by :
  - a) vacating the Examiner's Answer mailed August 29, 2007, and issuing a new Examiner's Answer which does not include a response to the Reply Brief,
  - b) properly responding to the Reply brief in a separate action, that complies with (MPEP) 1207.05(I), 37 CFR 41.43 (a)(2).
- (2) officially responding to the Appellants' communication filed October 19, 2007, and
- (3) for such further action as may be appropriate.

If there are any questions pertaining to this Order, please contact the Board of Patent Appeals and Interferences at 571-272-9797.

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